## II. REMARKS/ARGUMENTS

These Remarks are in response to the Office Action mailed June 3, 2005. No fee is due for the addition of any new claims.

Claims 1-26 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-7, 11-16 and 19-25, and objected to claims 8-10, 17, 18 and 26. The present response replies to the rejections, leaving for the Examiner's present consideration claims 1-26. Reconsideration of the rejections is respectfully requested.

### I. Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1-7, 11-16 and 19-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shaffer et al. (U.S. Patent 6,396,963; hereafter, "*Shaffer*"), and further in view of Chen et al. (U.S. Patent 6,307,550; hereafter, "*Chen*"). Claims 8-10, 17, 18 and 26 were objected to as being dependent upon a rejected base claim, but were stated to be allowable if rewritten in independent form.

It is respectfully submitted that *Shaffer* and *Chen*, either singly or in combination, fail to disclose or render obvious all the limitations of independent claim 1. *Shaffer* teaches a method and system for employing image recognition techniques to produce a photocollage from a plurality of images wherein the system obtains a digital record for each of the plurality of images, assigns each of the digital records a unique identifier and stories [sic] the digital records in a database; automatically sorts the digital records using at least one date [sic] type to categorize each of the digital records according at least [sic] one predetermined criteria [sic]; and generates a first draft of a photocollage from the digital records. (Abstract). *Chen* discloses a method for generating photographic images from a video. While *Shaffer* and *Chen* both disclose inventions that analyze local properties. By contrast, the invention discloses a compaction algorithm that takes into account global properties so that the resulting video collage represents the video more faithfully once the user has provided the constraints by selecting key frames for the template. *Shaffer* and *Chen* are missing two crucial ingredients of the current invention: 1) computing an importance score for each video segment; and 2) an algorithm for compacting the video segments. The compaction as disclosed by the current claims entails truncated the video segment relative to the other video segments chosen by the user for

inclusion in the template. The inventive algorithm does not merely compact but compacts in an optimal manner.

Claim 1 was rejected as unpatentable over *Shaffer*. Applicants respectfully traverse the rejection. The Office Action suggests (p. 3, 2nd para.) that *Shaffer* (col. 7, lines 24-31) discloses "associating a video segment from plurality of video segments with individual video frame of video collage template (see col. 7, lines 24-31, broadly reads on comparing to a threshold associated with the processing goal)." However, the cited section discloses that images are given an overall rating of technical quality based on the technical quality metrics. The cited section further discloses that the overall image quality metric is then compared to a threshold associated with the processing goal. The cited section further discloses that images whose quality rating falls below the threshold are flagged as unwanted. Finally, the cited section discloses that the specific threshold applied to a given image or set of images is parametrically determined using the processing goal and the customer profile as inputs. The cited section of *Shaffer* thus discloses *analysis* of images using a processing goal threshold and technical quality metrics. The cited section of *Shaffer* thus does not make any disclosure regarding *associating* a video segment from a plurality of video segments with an individual video frame of a *video collage template*. Associating a video segment with a video frame of a video collage template is an entirely separate art from image analysis as disclosed by the cited section of *Shaffer*.

The Office Action also suggests that *Shaffer* discloses "producing a video collage from video collage template and associated video segment (see col. 10, lines 1-13, broadly reads on the process of selecting the photo collage features such as size and format of individual pages." However, the cited section discloses that one means of performing this [layout] processing step is to employ a parametric photocollage description. The cited section further discloses that this description specifies the general structure of the photocollage but is not sufficient, of itself, to specify a final photocollage product. The cited section further discloses that the description file includes photocollage features such as number of sections, size and format of individual pages, maximum and minimum number of pages allowable, maximum and minimum number of customer images allowable per page, section descriptions, cover designs, location of allowable stock content, etc. The cited section finally discloses that by employing a photocollage description file a variety of tailored photocollage

products may be designed incorporating features specific to the design goals. The cited section of *Shaffer* discloses details of the layout process for generating a *photographic* collage consistent with a *description file*. The cited section of *Shaffer* thus does not make any disclosure regarding producing a *video* collage from a *video* collage *template* and an associated *video* segment.

Finally, the Office Action concedes (p. 3, 4th para.) that *Shaffer* does not explicitly call for segmenting video image data. The Office Action suggests (p. 3, 4th para.) that "at the same field of endeavor, Chen et al teaches this feature." However, despite the Office Action's suggestion otherwise, the art disclosed by *Shaffer*, producing a photographic collage from a plurality of images, cannot be equated with—and is in fact the *converse* process of--the art of *Chen*, which involves extracting photographic images starting from an input video. It may be noted that the fields of search determined by the United States Patent Office for the two patents are entirely nonoverlapping, again suggesting that *Shaffer* and *Chen* address disparate arts and different fields of endeavor which can in no way be equated.

Moreover, with respect to this rejection, the Office Action cites no motivation to combine the references. The Office Action provides a *benefit* for combining the references, but demonstrates no motivation, either explicit or implicit, in any of these references for combining them. The law is clear that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F,2d 680 (Fed. Cir. 1990). The Federal Circuit has held, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification*..... it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992).

Moreover, the Office Action appears to use impermissible hindsight in reaching its conclusion regarding obviousness. To reach a proper determination under 35 U.S.C. § 193, the Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Impermissible hindsight must be

avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. Manual of Patent Examining Procedure (hereafter, "MPEP") § 2142.

The references cited in the Office Action, including *Shaffer* and *Chen*, either singly or in combination, fail to disclose all of the limitations of claim 1. Claims 2-10 each ultimately depend from independent claim 1 and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

The Office Action notes that independent claim 11 (p. 4, para. 7), independent claim 19 (p. 5, para. 3), and independent claim 21 (p. 5, para. 3) are each found to be obvious due to *Shaffer*u in further view of *Chen* under analysis similar to the analysis of claim 1. The claim elements in claims 11, 19, and 21 roughly parallel the elements in claim 1. Since the Office Action applies reasoning to support the rejection of claims 11, 19, and 21 which is stated to be similar to the reasons for rejecting claim 1, with no further discussion provided, Applicants respond by incorporating by reference the responses given above with regard to claim 1. Thus the cited sections of *Shaffer* and *Chen* do not disclose or render obvious all the limitations of claims 11, 19, and 21.

The references cited in the Office Action, including *Shaffer* and *Chan*, either singly or in combination, fail to disclose all of the limitations of claims 11, 19, and 21. Claims 12-18, 20, and 22-26 each ultimately depend from one of the independent claims discussed above and are believed patentable for at least the same reasons as the independent claims and because of additional limitations of these claims.

Accordingly, claims 1-26 are believed patentable over the cited references and withdrawal of the rejections is respectfully requested.

## III. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all remaining claims, as amended in the subject patent application, should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of the patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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